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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/580,482 | 05/24/2006 | Makoto Seriu | 17214/011001 | 4206 |

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| EXAMINER | |
|---|---|
| KIM, AHSHIK | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2876 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 07/09/2010 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com
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| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/580,482 | SERIU ET AL. | |
| | Examiner | Art Unit | |
| | Ahshik Kim | 2876 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *4/16/10 (Response)*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *3* is/are allowed.

6)☒ Claim(s) *1 and 4* is/are rejected.

7)☒ Claim(s) *2* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/4/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response*

1. Receipt is acknowledged of the response filed on April 16, 2010. Currently claims 1-4 remain in the examination.

### *Obviousness-Type Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of US Patent 7,534,045 to Nakajima et al. (hereinafter "Nakajima")

It is acknowledged that claims 1 and 4 of the instant application and claim 1 of Nakajima are not identical in word by word manner. However, it is the Examiner's position that they are not patentably distinct. Comparison and analysis of claim 1 are as follows.

Both claims recite an IC tag bearing device comprising a sealing member. The sealing member is made of rubber or resinous elastic material with a core metal, seals a bearing space

delimited by raceway members. The IC tag on the device is capable of non-contact communications.

Claim 1 of Nakajima is narrower in scope since the claim further comprises a limitation, among other things, on how the IC tag is situated in relation to the raceway members, "wherein the IC tag is a cylinder, and arranged such that a longitudinal axis of the cylinder is outside the raceway members.

Claim 4 of the instant application is a broader version of claim 1 since it is omitting the limitation of sealing member being resinous or rubber. It merely states that "IC tag is fitted to the sealing member through an insulating piece."

Accordingly, it is the Examiner's position that claim 1 of Nakajima, although narrower in scope, fully discloses the subject matter of claims 1 and 4 of the instant application with additional limitation. To the extent that the instant claim is broader and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,607,135 B1 to Hirai et al. (hereinafter "Hirai").

Re claims 1 and 4, Hirai discloses an IC-tagged bearing device (see figure 5) having a bearing space 72 delimited between confronting raceway members 7, which space is sealed by non-contact sealing member such as resin with metal particles (see figure 4; col. 5, lines 20-33). The IC tag may be installed with an insulating piece 8c (see figure 24). The IC tag is comprised of antenna for wireless communication (see figure 3).

***Allowable Subject Matter***

6. Claim 3 is allowed.

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The claims are directed at a sealing member for IC-tagged bearing device. The is comprises of a sealing member for sealing space delimited between mutually confronting raceway members, and which is made of rubber or resinous elastic element equipped with core metal, wherein the IC tag is fitted to the core metal serving as antenna. The elastic element is interposed between the core metal and the raceway members. Such an IC-tagged bearing device is neither disclosed nor suggested by the cited references. The limitation of claim 2 wherein the surface of the core metal is covered with the elastic element except for a portion occupied by the IC tag is also allowable.

### *Response to Remarks*

9. Applicant's response filed on April 16, 2010 have been carefully reviewed and considered. Applicant's intention to defer filing of a Terminal Disclaimer is acknowledged. However, until a Terminal Disclaimer is filed and entered, the previously issued obviousness-type double patenting rejection remains standing.

Applicant's argument against Hirai is considered. However, the Examiner respectfully disagree with the Applicant's traversal. As described in paragraph 5 above, Hirai discloses an IC-tagged bearing device having a bearing having a bearing space delimited between confronting raceway members, which is sealed by non-contact sealing member. Accordingly, Applicant's argument is not persuasive. This Office Action is made final.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 8:00 AM to 5:00 PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (571)273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ahshik Kim/

Primary Examiner
Art Unit 2876
July 6, 2010